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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,202	03/11/2002	Yasushi Ueda	MTS-3294US	9517
7590	07/14/2005		EXAMINER	
Allan Ratner Ratner & Prestia PO Box 980 Valley Forge, PA 19482-0980			PATEL, GAUTAM	
			ART UNIT	PAPER NUMBER
			2655	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/980,202

Applicant(s)

UEDA ET AL.

Examiner

Gautam R. Patel

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Election/Restriction**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

A. Claims 1-2, 20 and 23cv are drawn to a data reproduction apparatus for data error correction, classified in Class 369, subclass 53.35.

B. Claims 3-8, 19-20 and 24 are drawn to a data reproduction apparatus for phase timing or synchronization classified in Class 369, subclass 47.28.

C. Claims 9-10, 21 and 25 are drawn to a data reproduction apparatus for defect detection, classified in Class 369 subclass 53.15.

D. Claims 11-15, 19, 21 and 26 are drawn to a data reproduction apparatus for defect detection for phase timing and defect detection, classified in Class 369 subclass 53.15 & 47.28.

E. Claims 16, 22 and 27 are drawn to a data reproduction apparatus for reproducing data based on land and track and groove track, classified in Class 369 subclass 111.

F. Claims 17-19 22 and 28 are drawn to a data reproduction apparatus for phase timing and structure of the track itself, classified in Class 369 subclass 47.28 and 111.

Inventions A and B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention B has separate utility such as with a data correction for data recording apparatus. See MPEP § 806.05(d).

Inventions A and C are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention C has separate utility such as with defect detection of optical medium or magnetic medium, which does not require particulars of error correction means. See MPEP § 806.05(d).

Inventions A and D are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention D has separate utility such as with defect detection of optical medium or magnetic medium, which does not require particulars of synchronization, and synchronization has separate utility for data recording apparatus. See MPEP § 806.05(d).

Inventions A and E are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention E has separate utility such as with track structure of optical medium or magnetic medium, which does not require particulars of error correction means at all. Error correction due to light reflection does not require particulars of track structure. See MPEP § 806.05(d).

Inventions A and F are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention F has separate utility such as with track structure of optical medium or magnetic medium, which does not require particulars of error correction means at all. Error correction due to light reflection does not require particulars of track structure. See MPEP § 806.05(d).

Similar arguments are applicable to inventions B to inventions C, D, E and F.

In addition, similar arguments are applicable for inventions C to inventions D, E and F. In addition, for inventions D to inventions E and F.

Inventions E and F are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the apparatus does not require a disk having land and groove structure for its operation. The subcombination has separate utility such as with a recording apparatus with different structure of track and groove.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. In addition, the Applicants are also required elect species from whichever of the above group they elect. For group A, B, C, D, E or F

This groups contains claims directed to the following patentably distinct species of the claimed invention:

The data reproduction apparatus of:

- a) Fig. 1 [first embodiment];
- b) Fig. 2 [second embodiment];
- c) Fig. 3 [third embodiment].

It is assumed that rest the variations are aspects only, are obvious, and do NOT represent different species or inventions. If they do they can be also qualify for restriction.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. A telephone call was made to Mr. Calder on July 11, 2005; to request an oral election to the above restriction requirement, but did not result in an election being made.

NOTE: Mr. Calder requested that a formal restriction be sent out for examination of the client.

#### ***Important Preliminary Notes***

4. First, the Examiner would like to thank Mr. Calder for sending a readable copy of the specification and claims and also correcting minor mistakes within the specification.

- a. The ABSTRACT needs to be in a **single paragraph** and on separate page.
- b. Claims 23-28 are in wrong format [they should be written in independent form with all the limitations of the claim 1 or appropriate claim.
- c. Claims 23-28 **will be rejected under 101 in their present format.**

5. Applicant is reminded that **upon the cancellation of claims to a non-elected invention, the inventorship must be amended** in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

6. A shortened statutory period for response to this action is set to expire **1 (one) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

#### **Contact information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

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Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read 'G.R.P.', is positioned above the printed name.

**GAUTAM R. PATEL  
PRIMARY EXAMINER**

Gautam R. Patel  
Primary Examiner  
Group Art Unit 2655

July 11, 2005